

converter so that the converter converts the digital data read from the storage medium into at least one of visible and audible data; and

a third switch position which connects the digital data provided by the communication path to the storage medium so that the digital data provided via the communication path is stored in the storage medium.

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22. (ONCE AMENDED) An apparatus comprising:

first means for connecting digital data provided by a communication path to a converter that converts the digital data into at least one of visible and audible data;

second means for connecting digital data read from a storage medium to the converter so that the converter converts the digital data read from the storage medium into at least one of visible and audible data; and

third means for connecting the digital data provided by the communication path to the storage medium so that the digital data provided via the communication path is stored in the storage medium.

REMARKS

Claims 1-22 are pending in this application. Claims 1-7 have been allowed, while claims 8-22 have been rejected. Amendments to claims 8, 12, 16, and 20-22 are presented above. In accordance with the foregoing, claims 8, 12, 16, and 20-22 have been amended without narrowing the claims within the meaning of Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 56 USPQ2d 1865 (Fed. Cir. 2000). No new matter is being presented, and approval and entry are respectfully requested.

Request for Information Disclosure Statement (IDS)

In item 2 on page 2 of the Office Action, the Examiner requested the Applicants to file an IDS as filed in the parent application. Applicants will file the IDS within two months from the filing date of this Amendment.

Rejections Under 35 U.S.C. §251

In item 6 on page 3 of the Office Action, the Examiner rejected claims 8-22 under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter. Applicants respectfully traverse this rejection for the following reasons.

If a reissue claim is as broad or broader in an aspect pertaining to a prior art rejection, but narrower in another aspect unrelated to the rejection, then the recapture rule may bar the claim. However, the recapture rule may be overcome if the claim is “materially narrower” in other overlooked aspects of the invention. Claim elements are materially narrower if they were not present in the original claims, or if these elements were not pointed out in arguments attempting to overcome a rejection during the original prosecution. See Hester Industries v. Stein, Inc., 142 F.3d 1472, 1482-83 (Fed. Cir. 1998).

The Examiner has asserted improper recapture of “input switchover means” and “output route switchover means” because the reissue claims do not recite these features. However, the features of a converter or an information converting means converting the digital information into visible and/or audible data were added to independent reissue claims 8, 12, 16, and 20-22. These features materially narrow the scope of the reissue claims by converting digital information received into visible and/or audible data for presentation to a user. Further, these features were not present in the original claims, and were not pointed out in arguments attempting to overcome a rejection during the original prosecution. Therefore, the recapture rule has been overcome.

On page 3 of the Office Action, the Examiner also asserted improper recapture of “signal processing means” and “error processing means.” However, these features were added to original claims 1 and 7, but not to original claims 4 and 6. Thus, because these features were not recited in original claims 4 and 6, the recapture rule should not apply to these features.

Therefore, Applicants respectfully request withdrawal of the rejections under §251.

The Oath/Declaration

In items 4 and 5 on page 2 of the Office Action, the Examiner rejected claims 1-22 under 35 U.S.C. §251 as being based upon a defective reissue declaration. Applicants will submit a supplemental declaration upon allowance of the claims.

The Objection to the Drawings

In item 3 on page 3 of the Office Action, the Examiner objected to Figure 2 for the reasons set forth therein. Applicants provide a proposed drawing correction in red ink for Figure 2 with this response, including an accompanying Letter to the Examiner Requesting Approval of the Changes to the Drawings. Accordingly, Applicants respectfully request withdrawal of the objection to the drawings.

The Objection to the Specification

In item 8 on page 4 of the Office Action, the Examiner objected to the specification for the same reason as the objection to the drawings. Applicants submit that the amendment of Figure 2 above resolves the outstanding objection to the specification.

Rejections Under 35 U.S.C. §112, First Paragraph

In item 9 on page 4 of the Office Action, the Examiner rejected claims 8, 12, 16, and 20-22 under 35 U.S.C. §112, first paragraph for not being enabling. Specifically, the Examiner asserted that the terms “visible” and “audible” are not supported by the specification because the specification uses the terms “image” and “sound.” Applicants respectfully traverse this rejection for the following reasons.

The terms “visible” and “audible” were used on line 8 of the original abstract. According to MPEP §608.01(b), the abstract is considered to be a part of the specification for the purpose of compliance with 35 U.S.C. §112, first paragraph. Accordingly, Applicants respectfully request withdrawal of the rejection under §112, first paragraph.

Rejections Under 35 U.S.C. §112, Second Paragraph

In item 10 on page 5 of the Office Action, the Examiner rejected claims 8, 12, 16, and 20-22 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants submit that amendments to the claims presented above provide the required definiteness. Accordingly, Applicants respectfully request withdrawal of the rejections to the claims under §112, second paragraph.

Rejections Under 35 U.S.C. §§102 and 103

In item 11 on pages 5-8 of the Office Action, the Examiner rejected claims 8-10, 12-14, 16-18, and 20-22 under 35 U.S.C. §102(e) as being anticipated by Shear (U.S. Patent No. 5,410,598). The Examiner also rejected claims 11, 15, and 19 under 35 U.S.C. §103(a) as being unpatentable over Shear in view of Allen (U.S. Patent No. 5,418,713). Applicants respectfully traverse these rejections for the reasons presented below.

The Invention

The present invention relates to the distribution and protection of copyrighted materials, such as computer programs. In one embodiment of the present invention, the copyrighted material is received by a digital information receiver receiving digital information via a communication medium such as the Internet. The digital information may also be received by a drive device using a removable storage medium such as a CD-ROM. A converter converts the digital information received into visible and/or audible data for presentation to a user. A switch selects routes for the data to travel between the digital information receiver and the converter, or between the drive device and the converter, or between the digital information receiver and the drive device.

The References

Shear. Shear relates to preventing unauthorized use of an electronic digital information database and measuring use of the database by authorized users at the user's site for billing the user according to the amount of the database used (Shear at col. 1, lines 20-25 and col. 3 line 63 to col. 4, line 2). The databases are predefined and encrypted and stored on a mass digital information storage medium, such as a CD-ROM (Shear at col. 9, lines 14-15 and col. 9, lines 47-55).

Allen. Allen relates to an on-demand data delivery system for previewing, selecting, retrieving, and reproducing, at remote locations, original recordings or programmed entertainment and software, together with related textual and graphical material and artwork on selected media, including compact disks. See Allen at col. 1, lines 11-20.

The Present Claimed Invention Distinguishes Over the Prior Art

Independent claim 8, as amended, recites "switch means for switching a connection between one of said digital information receiving means and said information converting means,

said digital information receiving means and said drive means, and said drive means and said information converting means."

The Examiner asserts on page 5 of the Office Action that the switch means of the present invention reads on the host computer interface logic 308 of Shear, as shown in Fig. 3 of Shear. However, the host computer interface logic 308 of Shear, which is contained within a decoder/biller 300, does not appear to operate as a switch. While the host computer interface logic 308 of Shear may control connections between the host computer 200 and the decoder/biller 300 and between the host computer 200 and the decoder control logic 316, the host computer interface logic 308 does not switch connections so that a particular route is selected.

Similar to claim 8, independent claims 12, 16, 20 and 21 specify a switch and claim 22 specifies first, second, and third means for selecting a particular communication path. Therefore, it is submitted that claims 8, 12, 16, and 20-22 patentably distinguish over the prior art.

As for the dependent claims, the dependent claims depend from the above-discussed independent claims and are patentable over the prior art for the reasons discussed above.

Therefore, Applicants submit that claims 8-22 patentably distinguish over the prior art. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under §§ 102 and 103.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all pending claims are deemed to be in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Please **AMEND** the following claims:

8. (ONCE AMENDED) An apparatus comprising:
digital information receiving means for receiving digital information provided via a communication medium;
drive means for reading digital information from, and writing digital information to, a removable storage medium;
information converting means for converting digital information received by said digital information receiving means and digital information read by said drive means into at least one of [the group consisting of] visible and audible data; and
switch means for switching [controlling] a connection between one of said digital information receiving means and said information converting means, [between] said digital information receiving means and said drive means, and [between] said drive means and said information converting means.

12. (ONCE AMENDED) An apparatus comprising:
a digital information receiver receiving digital information provided via a communication medium;
a drive device reading digital information from, and writing information to, a removable storage medium;
a converter converting digital information received by said digital information receiver and digital information read by said drive device into at least one of [the group consisting of] visible and audible data; and
a switch [controlling] switching a connection between said digital information receiver and said converter, between said digital information receiver and said drive device, and between said drive device and said converter.

16. (ONCE AMENDED) An apparatus comprising:
a communication path providing digital data;
a storage medium storing digital data;
a converter converting digital data into at least one of [the group consisting of] visible

and audible data; and

a switch having

a first switch position which connects digital data provided by the communication path to the converter so that the converter converts the digital data into at least one of [the group consisting of] visible and audible data,

a second switch position which connects digital data read from the storage medium to the converter so that the converter converts the digital data read from the storage medium into at least one of [the group consisting of] visible and audible data, and

a third switch position which connects digital data provided by the communication path to the storage medium so that the digital data provided via the communication path is stored in the storage medium.

20. (ONCE AMENDED) An apparatus comprising:

a communication path providing digital data;

a storage medium storing digital data;

a converter converting digital data into at least one of [the group consisting of] visible and audible data;

a decoder decoding encrypted digital data; and

a switch having

a first switch configuration which, when non-encrypted digital data is provided by the communication path, connects the digital information provided by the communication path to the converter without passing through the decoder so that the converter converts the digital data into at least one of [the group consisting of] visible and audible data,

a second switch configuration which, when encrypted digital data is provided by the communication path, connects the digital information provided by the communication path to the converter and the decoder so that the encrypted digital data is decoded by the decoder and then the decoded digital data is converted by the converter into at least one of [the group consisting of] visible and audible data,

a third switch configuration which, when non-encrypted digital data is read from the storage medium, connects the digital data read from the storage medium to the converter without passing through the decoder so that the converter converts the digital data into at least one of [the group consisting of] visible and audible data,

a fourth switch configuration which, when encrypted digital data is read from the

storage medium, connects the digital data read from the storage medium to the converter and the decoder so that the encrypted digital data is decoded by the decoder and then the decoded digital data is converted by the converter into at least one of [the group consisting of] visible and audible data, and

a fifth switch configuration which connects the digital data provided by the communication path to the storage medium so that the digital data provided via the communication path is stored in the storage medium.

21. (ONCE AMENDED) A switch comprising:

a first switch position which connects digital data provided by a communication path to a converter that [converters] converts the digital data into at least one of [the group consisting of] visible and audible data;

a second switch position which connects digital data read from a storage medium to the converter so that the converter converts the digital data read from the storage medium into at least one of [the group consisting of] visible and audible data; and

a third switch position which connects the digital data provided by the communication path to the storage medium so that the digital data provided via the communication path is stored in the storage medium.

22. (ONCE AMENDED) An apparatus comprising:

[a] first means [which connects] for connecting digital data provided by a communication path to a converter that [converters] converts the digital data into at least one of [the group consisting of] visible and audible data;

[a] second means [which connects] for connecting digital data read from a storage medium to the converter so that the converter converts the digital data read from the storage medium into at least one of [the group consisting of] visible and audible data; and

[a] third means [which connects] for connecting the digital data provided by the communication path to the storage medium so that the digital data provided via the communication path is stored in the storage medium.